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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,497	07/05/2001	Hirohisa A. Tanaka	05274.00016	8442
758	7590	08/25/2006	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			LANEAU, RONALD	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/898,497

Applicant(s)

TANAKA ET AL.

Examiner

Ronald Laneau

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 7/5/06 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 6-13, 15, 17-24, 26, 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby (US 2002/0077130 A1).

As per claim 1, Owensby discloses a method for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU) comprising the steps of: determining whether a location of the MU is inside or outside a predetermined subsidized zone (see paragraph 60); responsive to a determination that the location of the MU is inside the subsidized zone, adjusting the billing rate for the telecommunications connection to a first predetermined billing rate (see page 11, paragraph 72);

Art Unit: 3627

and responsive to a determination that the MU is outside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a second predetermined billing rate (it is inherent that a non-subsidized rate will apply when the user is not in a subsidized zone, see page 12, paragraph 79). Owensby does not explicitly disclose that it is responsive solely to a determination that the MU is inside or outside the predetermined subsidized zone but it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the method of Owensby as claimed since dealing with a mobile unit and it would be appropriate to determine the billing rate based solely to a determination of the MU on the inside or outside the subsidized zone. That would allow the system to target their ads based on the location of the subscriber's cell phone.

As per claim 2, Owensby discloses a method wherein the first predetermined billing rate is less than the second predetermined billing rate (it is inherent that the subsidized rate will be less than the non-subsidized rate).

As per claim 4, Owensby discloses a method wherein the location is determined by a Global Positioning System (GPS) (see page 7, paragraph 45).

As per claim 6, Owensby discloses a method wherein information corresponding to the predetermined subsidized zone is stored in a database (see page 8, paragraph 52).

As per claim 7, Owensby discloses a method wherein the predetermined subsidized zone information comprises a time period (see page 10, paragraph 64; wherein the Ad Selection is determined by among other things, "date and time"), and wherein the billing rate is reduced when the telecommunications connection occurred at least in part during the time period.

As per claim 8, Owensby discloses a method wherein the predetermined subsidized zone is defined by a geographical point and a radius (it is inherent that cellular phone systems include zones that are defined by a radius, see page 7, paragraph 45).

As per claim 9, Owensby discloses a method wherein the predetermined subsidized zone is associated with a proximity to a commercial establishment (see for example, page 3, paragraph 15, “restaurant in the area”) and the commercial establishment pays the first predetermined billing rate (it is inherent that the commercial establishment pays the subsidy).

As per claim 10, Owensby discloses a method wherein the predetermined subsidized zone is one of a plurality of predetermined subsidized zones, each associated with a proximity to a different commercial establishment (it is inherent that the system is used over in a plurality of locations with a plurality of commercial establishments, see page 10, paragraph 60); and

As per claim 11, Owensby discloses a method wherein the billing rate is reduced by a first amount when the location of the MU is within a first predetermined subsidized zone, and the billing rate is reduced by a second amount when the location of the MU is within a second predetermined subsidized zone (see page 11, paragraph 72, wherein it is noted that the subsidy is flexible and changes dependent on numerous factors).

As per claim 12, Owensby discloses a system for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU) comprising: a processor (operator billing system 32, see page 10, paragraph 60); memory for storing computer readable instructions that, when executed by the process, cause the system to perform billing operations. In regards to independent **claim 23**, Owensby discloses a computer program product for determining a billing rate of a mobile telecommunications connection

Art Unit: 3627

associated with a mobile telecommunications unit (MU) comprising a computer-readable medium containing computer program code for performing billing operations. In order to omit redundant explanations of claimed limitations, it is noted that Owensby discloses all the elements cited in claims 12-33 as outlined in detail for similar claims 1-11. Owensby does not explicitly disclose that it is responsive solely to a determination that the MU is inside or outside the predetermined subsidized zone but it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the method of Owensby as claimed since dealing with a mobile unit and it would be appropriate to determine the billing rate based solely to a determination of the MU on the inside or outside the subsidized zone. That would allow the system to target their ads based on the location of the subscriber's cell phone.

4. Claims 3, 5, 14, 16, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby (US 2002/0077130 A1) in view of Jones (US 6,411,891).

As per claims 3 and 5, Owensby discloses all of the limitations as set forth above but fails to explicitly state alternative methods of determining the geographic location of the mobile unit. Jones specifically teaches the use of detecting the geographic location of a mobile telecommunications unit by longitude and latitude (see column 17, lines 8-10) and Universal Transverse Mercator (UTM) numbers (see column 17, lines 8-10).

Since claims 14 & 16 and 25 & 27 are identical to claims 3 & 5, a detailed description of each limitation will not be repeated.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Owensby with the location detection mechanism of longitude/latitude or

Art Unit: 3627

UTM as taught by Jones, because the use of an accurate geographic location mechanism as taught will improve the efficiency and the successfulness of the advertisements, wherein the system will be able to better pinpoint the proximity of the mobile unit to a commercial establishment.

***Response to Arguments***

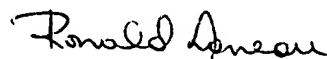
5. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on 5:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ronald Laneau  
Primary Examiner  
Art Unit 3627

8/17/06

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